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10/727,732	12/04/2003	Bo Andersson	0237.045	7176

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EXAMINER	
SCHNEIDER, CRAIG M	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/727,732
Filing Date: December 04, 2003
Appellant(s): ANDERSSON, BO

Lynn M. Comproski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/3/2006 appealing from the Office action mailed 5/16/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,105,516	WERRA ET AL.	10-1963
5,427,352	BREHM	6-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Werra et al. (3,105,516) in view of Brehm (5,427,352).

Werra et al. disclose a ball check valve comprising a housing having walls defining a fluid inlet (12), a fluid outlet (13), and a chamber communicating with the inlet and with the outlet (10), the chamber including a fluid passageway, a spherical hollow ball (18) in the chamber having a diametric cross sectional area larger than the area of the inlet, the spherical hollow ball being movable between a first, flow impeding position adjacent the inlet along a guide part to a second position spaced from the inlet and diverged from the fluid passageway to allow fluid to pass through the valve. Werra et al. further disclose that the spherical hollow ball is a metallic sphere enclosed by a coat of rubber or synthetic resin (col. 2, lines 5-8). Werra et al. does not disclose a plurality of spherical shock absorbing members contained within the spherical hollow ball. Brehm disclose a plurality of spherical shock absorbing members (73) contained within a valve body (col. 5, lines 7-51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the shock absorbing members that are in the valve of Brehm into the hollow ball of Werra at al., in order to dampen the movement of the ball.

Regarding claim 2, wherein the spherical shock absorbing members stabilize the spherical hollow ball while in transition between the first, flow impeding position and the second position (col. 5, lines 21-28).

Regarding claim 3, wherein the plurality of spherical shock absorbing members are metallic (col. 5, lines 50-51).

Regarding claim 5, wherein the plurality of spherical shock absorbing members only partially fill the spherical hollow ball (col. 5, lines 21-25).

(10) Response to Argument

At the top of page 7 of the brief, appellant argues that "[t]he noise caused by hydraulic shock waves and damage to the interior of the valve using a sold [sic, presumably solid] spherical ball in a ball check valve are also reduced by using a spherical hollow ball filled with a plurality of spherical shock absorbing members". It appears that appellant is now trying to assert that reducing the weight of the valve member is now a purpose of the invention. If this is the case, then the hollow ball of Werra et al. without modification would appear to be better suited to appellant's new-found advantage. However, the claimed invention requires spherical shock absorbing members within the hollow ball in order to dampen the motion of the moving valve member and the claims have been treated as such.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Patent of

Brehm discloses a chamber that is filled with spherical shock absorbing members to dampen the valve therefore "in order to dampen the movement". This is an explicit motivation (see the last sentence of the abstract) to combine the prior art of Brehm with Werra et al.

The appellant believes that since Werra et al. already teaches the use of a fluid cushion to dampen the ball then there is no motivation to employ the shock absorbing members of Brehn. The examiner asserts that Werra's dampening method is line condition responsive and that the addition of the balls of Brehm adds a further degree of dampening that is not responsive to the line conditions.

In response to appellant's argument that Brehm's Patent is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both prongs are met since both references are directed to valves that are in the same field of endeavor and both references are pertinent to the particular problem of dampening the motion of the moving valve member. Further regarding appellant's argument that one valve is fluid actuated, while the other has an electrical actuator, valve movement is not exclusive to line condition responsive valves, i.e. check valves; valve motion is axiomatic to all valves.

Although the rejection of claim 6 is presented under a separate heading, appellant merely adopts the argument stated in the brief regarding claim 1. Therefore, the examiner's arguments stated above are adopted with respect to claim 6.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Craig Schneider

Conferees:

Eric Keasel

John Rivell

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